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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Effective on 12/08/2004.
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL for FY 2005

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 250

Complete if Known

Application Number	09/879,823
Filing Date	June 12, 2001
First Named Inventor	CRAIG W. BARNETT
Examiner Name	Arthur D. Duran
Art Unit	3622
Attorney Docket No.	031792-0311530

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____

☒ Deposit Account Deposit Account Number: 033975 Deposit Account Name: PILLSBURY WINTHROP LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

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FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fee Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	150	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent	50	25
Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent	200	100
Multiple dependent claims	360	180

Total Claims - 20 or HP = _____ X Fee (\$) = Fee Paid (\$)

HP = highest number of total claims paid for, if greater than 20

Indep. Claims - 3 or HP = _____ X Fee (\$) = Fee Paid (\$)

HP = highest number of independent claims paid for, if greater than 3

Multiple Dependent Claims Fee (\$) Fee Paid (\$)

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets - 100 = _____ Extra Sheets /50= _____ Number of each additional 50 or fraction thereof x Fee (\$) 125.00 = Fee Paid (\$)

4. OTHER FEE(S)

Non-English Specification, 130 fee (no small entity discount)

Other: Brief in Support of Appeal

Fee Paid (\$)

250.00

SUBMITTED BY

Signature		Registration No. (Attorney/Agent)	47,429	Telephone	703.905.2141
Name (Print/Type)	Bradford C. Blaise	Date	February 10, 2005		

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE PATENT APPLICATION OF: Craig W. BARNETT *et al.*
SERIAL NO.: 09/879,823
ATTORNEY DOCKET NO: 031792-0311530 (24122-303-408)
FILING DATE: June 12, 2001
ART UNIT : 3622
EXAMINER A. DURAN
FOR: METHOD AND SYSTEM FOR ELECTRONIC DISTRIBUTION
OF PRODUCT REDEMPTION COUPONS

APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. §41.37

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Dear Sir:

Further to the Notice of Appeal filed on **August 10, 2004**, Appellants respectfully submit Appellants' Brief on Appeal pursuant to 37 C.F.R. §41.37.

Appellants have filed concurrently herewith a petition for a four-month extension of time. 37 C.F.R. §1.17(a)(4). The Director is authorized to charge \$1,045.00 to cover the \$795.00 petition fee, as well as the \$250.00 small entity fee for filing an Appeal Brief pursuant to 37 C.F.R. §41.20(b)(2). The Director is further authorized to charge any additional fees that may be due, or credit any overpayment of same to Deposit Account No. 033975 (Ref. No. 031792-0311530).

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REQUIREMENTS OF 37 C.F.R. §41.37

I. REAL PARTY IN INTEREST - 37 C.F.R. §41.37(c)(1)(i)

The real parties in interest are Black Diamond CCT Holdings, LLC, and E-centives, Inc.

II. RELATED APPEALS AND INTERFERENCES - 37 C.F.R. §41.37(c)(1)(ii)

A. Judicial Proceedings – U.S. Patent Nos. 6,321,208 and 6,336,099

This application is a continuation of U.S. Patent Application Serial No. 08/425,185, filed April 19, 1995, and issued as U.S. Patent No. 6,321,208, on November 20, 2001. U.S. Patent No. 6,321,208 as well as U.S. Patent No. 6,336,099 (which is also a continuation of U.S. Patent No. 6,321,208, and which issued on January 1, 2002) are currently the subject of pending litigation in the United States District Court for the District of Maryland Southern Division (Civil Action No. RDB-02-3701).

A Memorandum and Order Regarding Patent Claim Construction was issued on December 16, 2003, and is included herewith as **Exhibit A**.

B. Related Appeals

(1) U.S. Patent Application Serial No. 09/321,597, filed May 28, 1999, is a continuation of U.S. Patent No. 6,321,208. A Notice of Appeal was filed in this Application on August 10, 2004.

APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. §41.37
U.S. Application Serial No. 09/879,823
Attorney Docket No. 031792-0311530 (24122-303-408)

(2) U.S. Patent Application Serial No. 09/543,735, filed April 5, 2000, is a continuation of U.S. Patent No. 6,321,208. A Notice of Appeal was filed in this Application on August 10, 2004.

(3) U.S. Patent Application Serial No. 09/754,378, filed January 5, 2001, is a continuation of U.S. Patent No. 6,321,208. A Notice of Appeal was filed in this Application on August 10, 2004.

(4) U.S. Patent Application Serial No. 09/451,558, filed December 1, 1999, is a continuation of U.S. Patent No. 6,336,099 (which is a continuation of U.S. Patent No. 6,321,208). A Request for a Declaration of Interference with U.S. Patent No. 5,845,259 to West *et al.* is currently being sought. A Notice of Appeal was filed in this Application on August 10, 2004.

(5) U.S. Patent Application Serial No. 09/537,793, filed March 29, 2000, is a continuation of U.S. Patent No. 6,321,208. A Request for a Declaration of Interference with U.S. Patent No. 5,907,830 to Engel *et al.* is currently being sought. A Notice of Appeal was filed in this Application on August 10, 2004.

(6) U.S. Patent Application Serial No. 09/879,825, filed June 12, 2001, is a continuation of U.S. Patent No. 6,321,208. A Request for a Declaration of Interference with U.S. Patent No. 6,076,069 to Laor is currently being sought. A Notice of Appeal was filed in this Application on August 10, 2004.

(7) U.S. Patent Application Serial No. 10/871,381, filed June 21, 2004, is a continuation of U.S. Patent No. 6,321,208. A Request for a Declaration of Interference with U.S. Patent No. 6,584,448 to Laor is currently being sought. A First Office Action has not yet been received.

III. STATUS OF CLAIMS - 37 C.F.R. §41.37(c)(1)(iii)

Pending: Claims 47-62 are pending.

Cancelled: Claims 1-46 are cancelled.

Rejected: Claims 47-62 stand rejected.

Allowed: No claims have been allowed.

On Appeal: Claims 47-62 are appealed.

IV. STATUS OF AMENDMENTS - 37 C.F.R. §41.37(c)(1)(iv)

No amendments have been filed subsequent to the mailing of the Final Office Action on July 12, 2004 (hereinafter "Final Action").

V. SUMMARY OF CLAIMED SUBJECT MATTER - 37 C.F.R. §41.37(c)(1)(v)

One aspect of Appellants' invention relates to a system and method for providing coupons to a device coupled to a network. *See* Specification, *e.g.*, pg. 1, lines 3+.

According to an embodiment of the invention, an on-line service provider (2) comprises a centrally-located repository of electronically stored coupon data. On-line service provider (2) may include a database (40) (*see* FIGS. 6 and 10) for storing various packages of electronic coupon data. *See* FIG. 1; and Specification, *e.g.*, pg. 14, line 18 – pg. 15, line 25. On-line service provider (2) may further be accessible by any remote personal computer (6) via a data link (4). According to an embodiment of the invention, a user of remote personal computer (6) is able to request coupon data to be transmitted from on-line service provider (2), and is able to instruct his computer to print or electronically transfer product redemption coupons generated from the transmitted coupon data. *See*

Specification, *e.g.*, pg. 10, line 27 – pg. 11, line 15. Remote personal computer (6) has a printer (8) connected thereto. Printer (8) may print coupons for use in a normal fashion by a consumer when shopping at a desired retail store (10). *See* FIG. 1; and Specification, *e.g.*, pg. 15, line 27 – pg. 16, line 17.

According to an embodiment of the invention, a target audience of one or more users of devices coupled to a network is determined based on one or more preferences of the users stored in the respective users' devices. For example, preferences of a user of remote personal computer (6) may be stored in remote personal computer (6). As an example, the remote personal computer (6) may include a coupon data management routine (32) stored thereon. *See* Specification, *e.g.*, pg. 16, lines 5-10. Referring to FIG. 2, computer (6) may be configured to operate via a coupon database file (30) and an offline coupon data management routine file (32) loaded onto a fixed memory such as a hard disk drive. *See* Specification, *e.g.*, pg. 20, lines 16-20. Coupon database file (30) stored on computer (6) may include, among other data, selected coupon data (30b) representing specific coupons electronically “clipped” by a user, and user-specific data (30d). *See* FIG. 2. A record is also kept by the coupon upload routine (32cc), on computer (6), indicative of each coupon selected by the user and each coupon printed by the user. This information is provided to online service provider (2) when the coupon upload routine (32cc) is called. *See* Specification, *e.g.*, pg. 24, lines 26+.

According to an embodiment, a target audience is determined based on one or more preferences of the users (*e.g.*, based on information stored in the respective personal computers). As recited above, the preferences may be provided to online service provider (2) when the coupon upload routine (32cc) is called. *See* Specification, *e.g.*, pg. 24, lines 26+. Information collected by a coupon distributor (16) from the online service provider

(2) regarding the coupon data selected by the user, the coupon data printed by the user, and the requested demographic information is stored in a database (11) along with information from a coupon redemption center (13) regarding the coupons actually redeemed by the user. The database (11) further stores information regarding all coupons which are made available by the various coupon issuers (14) from which it will generate coupon data packages for subsequent downloading to users. The information stored in the database (11) is input to the marketing and targeting analysis means (17) (*see* FIG. 1), which carries out the function of analyzing the aforementioned information in a manner known in the art to arrive at different coupon packages. That is, it may be determined by the analysis means (17) that users with dogs in their household (which is known by the demographic responses) will get a certain package comprising dog food coupons. *See* Specification, *e.g.*, pg. 29, lines 14-21. In at least one embodiment, the recitation of “means for determining a target audience” (in claims 52-54) may refer to *at least* marketing and targeting analysis means (17) (*see* FIG. 1) as described above, and the interaction thereof with personal computer (6), coupon data management routine (32), coupon database file (30), selected coupon data (30b), user-specific data (30d), coupon upload routine (32cc), on-line service provider (2), coupon distributor (16), database (11), coupon redemption center (13), or various coupon issuers (14) as explained in detail above.

According to an embodiment of the invention, a coupon is provided to the target audience determined, and each coupon may be used a predetermined number of times. For example, coupon data can be transmitted from on-line service provider (2) to remote personal computer (6), and a user is able to instruct his computer to print or electronically transfer product redemption coupons generated from the transmitted coupon data. *See* Specification, *e.g.*, pg. 10, line 27 – pg. 11, line 15. According to an embodiment of the

invention, redemption of coupons provided to users may be monitored such that each coupon may be used a predetermined number of times. For example, according to one embodiment, each coupon may have a unique user bar code (90) that renders the electronic coupon system of the invention secure and virtually fraud-proof. A user is able to print out a particular coupon (18) once, for example, and because each coupon printed by a user is unique, and because the scanning of a coupon presented for redemption will be stored at a coupon redemption center, a coupon issuer will know if a particular user has redeemed a particular coupon and thus disallow further redemption of a photocopied coupon bearing the same indicia. *See* Specification, e.g., pg. 25, line 29 – pg. 26, line 12. The recitation of “means for providing a coupon to the target audience, wherein each coupon may be used a predetermined number of times” (in independent claim 52) may refer to *at least* the transmission of coupon data from on-line service provider (2) to personal computer (6), and for the use of a unique user bar code (90) on a printed coupon (18) as described in detail above.

According to an embodiment of the invention, providing a coupon to the target audience may further comprise determining a subset of users of the network based on a preference profile, and delivering one or more coupons to the subset of users. This is also known as targeting. Referring to the dog food example referenced above, for instance, it may be further determined that users who select, print and redeem dog food coupons of “Brand X” will get coupons issued by “Brand Y,” or will get only low value coupons since they are already dog food coupon users, *etc.* Thus, the analysis means (17) (*see* FIG. 1) generates a number of differing coupon data packages for transmittal to the online service provider (2). The analysis means (17) also provides specific mapping information which will instruct the online service provider (2) as to which user(s) should be provided with

which package(s). For example, user 1 may be mapped to coupon data packages 2 and 3; user no. 2 to packages 3 and 6, *etc.* This mapping function may be carried out by the coupon distributor and provided to the online service provider at regular intervals, *e.g.* once per week. Thus, the coupon selection, printing and redemption habits may be analyzed over a time period and used to determine the subsequent targeted packages. *See* Specification, *e.g.*, pg. 29, line 21 – pg. 30, line 10. The recitation of “means for determining a subset of users of the network based on a preference profile...and means for delivering one or more coupons to the subset of users” (in claims 52-54) may refer to *at least* the marketing and targeting analysis means (17) (*see* FIG. 1), as well as the transmission of coupon data from on-line service provider (2) to personal computer (6) as described above.

As recited above, redemption of coupons provided to users may be monitored such that each coupon may be used a predetermined number of times. Monitoring redemption may prevent fraud. *See* Specification, *e.g.*, pg. 9, lines 11-15. The recitation of “means for monitoring redemption of the one or more coupons such that each coupon may be used a predetermined number of times” (in claims 52 and 55) may refer to *at least* the use of a unique user bar code (90) on a printed coupon (18) as described in detail above.

The recitation (in dependent claim 53) of “means for monitoring network usage of users” and “means for determining a preference profile for respective users, wherein the preference profile is based on network usage by the respective users and is stored in respective user client devices” may refer to *at least* the marketing and targeting analysis means (17) (*see* FIG. 1) as described above, and the interaction thereof with personal computer (6), coupon data management routine (32), coupon database file (30), selected coupon data (30b), user-specific data (30d), coupon upload routine (32cc), on-line service

provider (2), coupon distributor (16), database (11), coupon redemption center (13), and/or various coupon issuers (14). For example, as recited above, preferences of a user of remote personal computer (6) may be stored in remote personal computer (6). As an example, the remote personal computer (6) includes a coupon data management routine (32) stored thereon. *See* Specification, *e.g.*, pg. 16, lines 5-10. Referring to FIG. 2, computer (6) may be configured to operate via a coupon database file (30) and an offline coupon data management routine file (32) loaded onto a fixed memory such as a hard disk drive. *See* Specification, *e.g.*, pg. 20, lines 16-20. Coupon database file (30) stored on computer (6) includes, among other data, selected coupon data (30b) representing specific coupons electronically “clipped” by a user, and user-specific data (30d). *See* FIG. 2. A record is also kept by the coupon upload routine (32cc), on computer (6), indicative of each coupon selected by the user and each coupon printed by the user. This information is provided to online service provider (2) when the coupon upload routine (32cc) is called. *See* Specification, *e.g.*, pg. 24, lines 26+.

Thus, network usage (*e.g.*, the coupon selection, printing, and redemption habits) of a user are provided to the marketing and targeting analysis means (17) (*see* FIG. 1) as described above, such that specific mapping (targeting) information is generated which will instruct the online service provider (2) as to which user(s) should be provided with which package(s). *See* Specification, *e.g.*, pg. 29, line 21 – pg. 30, line 10.

The recitation (in dependent claim 54) of “means for determining a preference profile for respective users, wherein the preference profile is based on revealed preferences of the respective users” may refer to *at least* the same components identified above with regard to dependent claim 53, as information regarding coupons that have been selected, printed, or redeemed by a user comprise revealed preferences.

The recitation (in dependent claim 55) of “means for maintaining a coupon database that stores information related to coupons that have been distributed; and means for checking the coupon database to determine whether a particular coupon is valid” may refer to *at least* the database (11), coupon redemption center (13), coupon distributor (16), coupon issuers (14) and/or online service provider (2). For example, coupon data selected by the user, the coupon data printed by the user, and the requested demographic information is stored in a database (11). The database (11) may further store information from the coupon redemption center (13) regarding the coupons actually redeemed by the user. The database (11) further stores information regarding all coupons which are made available by the various coupon issuers (14) from which it will generate coupon data packages for subsequent downloading to users. *See* FIG.1; and Specification, e.g., pg. 29, lines 1-12.

The recitation (in dependent claim 56) of “means for serializing the coupons such that each coupon may be redeemed once” may refer to *at least* the use of a unique user bar code (90) on a printed coupon (18) as described in detail above.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL - 37 C.F.R. §41.37(c)(1)(vi)

A. Claims 47, 52, 57, 61, and 62 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. *See* Final Action, pg. 2, ¶4.

B. Claims 47-62 stand rejected under 35 U.S.C. §102(b) as allegedly being unpatentable over U.S. Patent No. 5,227,874 to Von Kohorn. *See* Final Action, pg. 4, ¶5.

C. The Examiner has failed to initiate an Interference between the above-identified application, and U.S. Patent No. 6,075,971 to Williams *et al.* See Final Action, pg. 2, ¶2.

VII. ARGUMENTS - 37 C.F.R. §41.37(c)(1)(vii)

Each rejection should be reversed for the reasons set forth herein.

A. Claims 47, 52, 57, 61, and 62 are supported by the Specification.

Independent claims 47, 52, 57, 61, and 62 are supported by the Specification and satisfy the requirements of 35 U.S.C. §112, first paragraph. While claims 47, 52, 57, 61, and 62 are separately patentable, Appellants' arguments have been organized below by claim element, rather than by claim, so as to address the Examiner's arguments in the Final Action in the order in which they were presented. After addressing the common elements, a separate argument with respect to each claim is then presented.

35 U.S.C. §112, first paragraph recites:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

To satisfy the written description requirement of 35 U.S.C. §112, first paragraph, an applicant must "convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*." *Vas-Cath Inc. v.*

Mahurkar, 935 F.2d 1555, 1563-1564, 19 U.S.P.Q. 2d (BNA) 1111, 1117 (Fed. Cir. 1991)
(emphasis in original).

To satisfy the written description requirement, it is not necessary for the claimed subject matter to be described in haec verba in the specification. *University of Rochester v. G.D. Searle & Co., Inc.*, 358 F.3d 916, 922-923, 69 U.S.P.Q. 2d (BNA) 1886, 1892 (Fed. Cir. 2004). Rather, “the written description requirement can be satisfied by ‘words, structures, figures, diagrams, formulas, etc.’” *Koto Manufacturing Co., Ltd. v. Turn-Key-Tech, LLC*, 381 F.3d 1142, 1154, 72 U.S.P.Q. 2d (BNA) 1190, 1199 (Fed. Cir. 2004) (quoting *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572, 41 U.S.P.Q. 2d (BNA) 1961, 1966 (Fed. Cir. 1997)).

For each claim element identified by the Examiner, Appellants have provided below exemplary citations to the Specification and/or drawing figures where support can be found. It should be understood, however, that the citations set forth are not exclusive. The Specification discloses numerous embodiments, and various system elements disclosed therein may perform various functions, or be coupled with one or more other system elements to perform various functions depending on the embodiment. As such, the following citations should not be viewed as limiting.

1. Claims 47, 52, 57, 62

With regard to claims 47, 52, 57, & 62, the Examiner erroneously alleges that the Specification fails to provide support for “*wherein each coupon may be used a predetermined number of times,*” and “*monitoring redemption of the one or more coupons such that each coupon may be used a predetermined number of times.*” See Final Action, pgs. 2-3.

As discussed and agreed during the personal interview on June 3, 2003, and further acknowledged in the Interview Summary signed by Primary Examiner James W. Myhre, the Specification supports setting the predetermined number of times to at least one. *See* Interview Summary (Paper No. 8). Additionally, as acknowledged in the Interview Summary, “*Since the Applicant had support for a subset of the above feature, the 35 U.S.C. 112 rejection of the claims will be withdrawn upon receipt of a response.*” *Id.* Yet the rejection has been improperly maintained despite clear support for these claim elements based on the facts set forth above. Accordingly, the rejection of claims 47, 52, 57, & 62 should be reversed.

2. Claims 47, 52, 57, 61, 62

With regard to claims 47, 52, 57, 61, & 62, the Examiner erroneously alleges that the Specification fails to provide support for “*preferences of respective users stored in the respective user’s devices.*” *See* Final Action, pgs. 3-4. This claim language is fully supported as evidenced by the Specification and drawings.

According to an embodiment of the invention, the remote personal computer (6) may include a coupon data management routine (32) stored thereon. *See* Specification, *e.g.*, pg. 16, lines 5-10. Referring to FIG. 2, computer (6) may be configured to operate via a coupon database file (30) and an offline coupon data management routine file (32) loaded onto a fixed memory such as a hard disk drive. *See* Specification, *e.g.*, pg. 20, lines 16-20. Coupon database file (30) stored on computer (6) includes, among other data, selected coupon data (30b) representing specific coupons electronically “clipped” by a user, and *user-specific data* (30d). *See* FIG. 2. A record is also kept by the coupon upload

routine (32cc), on computer (6), indicative of each coupon *selected* by the user and each coupon *printed* by the user. *See* Specification, *e.g.*, pg. 24, lines 26+. ***Emphasis added.***

As these exemplary citations to the Specification and drawing figures illustrate, the Specification supports the feature of storing preferences of a user (*e.g.*, coupons that a user has viewed, selected, printed, *etc.*) on the user's computer. Accordingly, the rejection of claims 47, 52, 57, 61, & 62 should be reversed.

Having presented the foregoing arguments organized by challenged claim element, Appellants submit that independent claims 47, 52, 57, 61, and 62 are separately patentable, that each is supported by the Specification, and that each satisfy the requirements of 35 U.S.C. §112, first paragraph.

Claim 47

For at least the reasons presented above, claim 47 has support for each of the challenged claim elements and satisfies the requirements of 35 U.S.C. §112, first paragraph. *See* Sections (VII)(A)(1) and (2) of the Appeal Brief.

Claim 52

For at least the reasons presented above, claim 52 has support for each of the challenged claim elements and satisfies the requirements of 35 U.S.C. §112, first paragraph. *See* Sections (VII)(A)(1) and (2) of the Appeal Brief.

Claim 57

For at least the reasons presented above, claim 57 has support for each of the challenged claim elements and satisfies the requirements of 35 U.S.C. §112, first paragraph. *See* Sections (VII)(A)(1) and (2) of the Appeal Brief.

Claim 61

For at least the reasons presented above, claim 61 has support for each of the challenged claim elements and satisfies the requirements of 35 U.S.C. §112, first paragraph. *See* Section (VII)(A)(2) of the Appeal Brief.

Claim 62

For at least the reasons presented above, claim 62 has support for each of the challenged claim elements and satisfies the requirements of 35 U.S.C. §112, first paragraph. *See* Sections (VII)(A)(1) and (2) of the Appeal Brief.

B. **Claims 47-62 are Patentable Over U.S. Patent No. 5,227,874 to Von Kohorn.**

The Examiner legally erred in rejecting claims 47-62 under 35 U.S.C. §102(b) as being unpatentable over U.S. Patent No. 5,227,874 to Von Kohorn for *at least* the reason that Von Kohorn neither explicitly nor impliedly discloses each of the elements of claims 47-62. “A prior art reference anticipates a patent claim if the reference discloses, either expressly or inherently, all of the limitations of the claim.” *Metabolite Laboratories, Inc. v. Laboratory Corporation of America Holdings*, 370 F.3d 1354, 1367, 71 U.S.P.Q. 2d (BNA) 1081, 1090 (Fed. Cir. 2004) (quoting *EMI Group N. Am., Inc. v. Cypress*

Semiconductor Corp., 268 F.3d 1342, 1350, 60 U.S.P.Q. 2d (BNA) 1423, 1429 (Fed. Cir. 2001) (citation omitted)).

1. Independent claims 47, 52, 57, 61, and 62

Independent claims 47, 52, 57, 61, and 62 each generally recite, *inter alia*, the claim elements of:

1. determining a target audience of one or more users of devices coupled to a network, wherein the target audience is determined based on one or more preferences of the users stored in the respective users' devices;
2. providing a coupon to the target audience determined, wherein each coupon may be used a predetermined number of times; and
3. wherein providing a coupon to the target audience further comprises determining a subset of users of the network based on a preference profile.

In the Final Action (at pgs. 4-5), the Examiner alleges that the following passages of Von Kohorn disclose these claim elements: (1) col. 2, lines 20-25; (2) col. 2, lines 4-14; (3) col. 104, line 65 – col. 105, line 31; and (4) col. 105, line 65 – col. 106, line 10. None of these cited passages, however, appear to disclose *at least* the aforementioned claim elements.

At best, the passages relied upon by the Examiner appear to disclose that information is conveyed via electronic signals, and that a dispenser unit is provided with means to either accept or reject the signals depending on whether the information conveyed by the electronic signals is, or is not, intended for the owner of the dispenser unit. These passages do not appear to disclose storing user preferences on a dispenser unit.

As such, these passages also fail to disclose determining a target audience based on the stored preferences, as well as determining a subset of users based on a preference profile. Furthermore, these passages appear to be silent with regard to enabling a coupon to be used a predetermined number of times.

For *at least* these reasons, the rejection of independent claims 47, 52, 57, 61, and 62 under 35 U.S.C. §102(b) should be reversed.

Appellants submit that dependent claims 48-51, 53-56, and 58-60 are allowable for at least the reason that they depend from allowable independent claims (for the reasons set forth above), as well as for the further limitations they contain.

2. Dependent claims 48-49, 53-54, and 58-59

Dependent claims 48-49, 53-54, and 58-59 each recite claim elements directed toward a preference profile. The passages in Von Kohorn relied upon by the Examiner in the Final Action (at pgs. 5-6) do not appear to disclose these claim elements.

3. Dependent claims 50, 55, and 60

Dependent claims 50, 55, and 60 each generally recite, *inter alia*, the claim element of checking a coupon database to determine whether a particular coupon is valid, while dependent claims 51 and 56 each generally recite, *inter alia*, the claim element of serializing the coupons such that each coupon may be redeemed only once. The passages in Von Kohorn relied upon by the Examiner in the Final Action (at pg. 6) do not appear to disclose these claim elements.

As such, the rejection of claims 47-62 under 35 U.S.C. §102(b) as being unpatentable over U.S. Patent No. 5,227,874 to Von Kohorn is improper and should be reversed.

C. An Interference should be declared between the above-identified application, and U.S. Patent No. 6,075,971 to Williams *et al.*

For at least the reason that the claims are supported by the specification, patentable over the alleged prior art, and a copy of the issued claims of U.S. Patent No. 6,075,971 to Williams *et al.*, an interference-in-fact exists. Accordingly, Appellants request that such an interference be declared between the above-identified application, and U.S. Patent No. 6,075,971 to Williams *et al.*

To the extent that the Examiner continues to allege unpatentability of the pending claims under 35 U.S.C. §102, Appellants note that the U.S. Patent Office, for consistency, should institute a reexamination of U.S. Patent No. 6,075,971 to Williams *et al.*

IX. CLAIMS APPENDIX - 37 C.F.R. §41.37(c)(1)(viii)

The pending claims (claims 47-62) are attached in the Appendix.

CONCLUSION

For at least the foregoing reasons, Appellants respectfully request that the rejections of each of pending claims 47-62 be reversed.

Date: **February 10, 2005**

Respectfully submitted,

By:


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CLAIMS APPENDIX

Claims 1-46. *cancelled*

47. ***(Previously Presented)*** A method comprising:

determining a target audience of one or more users of devices coupled to a network, wherein the target audience is determined based on one or more preferences of the users stored in the respective users' devices; and

providing a coupon to the target audience determined, wherein each coupon may be used a predetermined number of times, wherein providing a coupon to the target audience further comprises:

determining a subset of users of the network based on a preference profile;

delivering one or more coupons to the subset of users; and

monitoring redemption of the one or more coupons such that each coupon may be used a predetermined number of times.

48. ***(Previously Presented)*** The method of claim 47, wherein determining a target audience further comprises:

monitoring network usage by the users;

determining a preference profile for respective users, wherein the preference profile is based on network usage by the respective users; and

selecting a subset of users of the network based on the preference profile.

49. ***(Previously Presented)*** The method of claim 47, wherein determining a target audience further comprises:

determining a preference profile for respective users, wherein the preference profile is based on revealed preferences of the respective users; and

selecting a subset of users of the network based on the preference profile.

50. ***(Previously Presented)*** The method of claim 47, wherein monitoring redemption of the one or more coupons further comprises:

maintaining a coupon database that stores information related to coupons that have been distributed; and

checking the coupon database to determine whether a particular coupon is valid.

51. ***(Previously Presented)*** The method of claim 47, wherein monitoring redemption the one or more coupons further comprises serializing the coupons such that each coupon may be redeemed once.

52. *(Previously Presented)* An apparatus for providing coupons to a device coupled to a network comprising:

means for determining a target audience of one or more users of devices coupled to the network, wherein the target audience is determined based on one or more preferences of respective users stored in the respective client devices; and

means for providing a coupon to the target audience, wherein each coupon may be used a predetermined number of times, wherein means for providing a coupon to the target audience further comprises:

means for determining a subset of users of the network based on a preference profile;

means for delivering one or more coupons to the subset of users; and

means for monitoring redemption of the one or more coupons such that each coupon may be used a predetermined number of times.

53. *(Previously Presented)* The apparatus of claim 52, wherein means for determining a target audience further comprises:

means for monitoring network usage of users;

means for determining a preference profile for respective users, wherein the preference profile is based on network usage by the respective users and is stored in respective user client devices; and

means for selecting a subset of users of the network based on the preference profile.

54. *(Previously Presented)* The apparatus of claim 52, wherein means for determining a target audience further comprises:

means for determining a preference profile for respective users, wherein the preference profile is based on revealed preferences of the respective users; and

means for selecting a subset of users of the network based on the preference profile.

55. *(Previously Presented)* The apparatus of claim 52, wherein means for monitoring redemption of the one or more coupons further comprises:

means for maintaining a coupon database that stores information related to coupons that have been distributed; and

means for checking the coupon database to determine whether a particular coupon is valid.

56. *(Previously Presented)* The apparatus of claim 52, wherein means for monitoring the one or more coupons further comprises means for serializing the coupons such that each coupon may be redeemed once.

57. *(Previously Presented)* A machine readable medium having stored thereon sequences of instructions that, when executed by one or more processors, cause an electronic device to:

determine a target audience of one or more users of devices coupled to the network, wherein the target audience is determined based on one or more preferences of respective users stored in the respective client devices; and

provide a coupon to the target audience, wherein each coupon may be used a predetermined number of times, wherein the sequences of instructions that cause the electronic device to provide a coupon to the target audience further comprises sequences of instructions that, when executed, cause the electronic device to:

determine a subset of users of the network based on a preference profile;

deliver one or more coupons to the subset of users; and

monitor redemption of the one or more coupons such that each coupon may be used a predetermined number of times.

58. *(Previously Presented)* The machine readable medium of claim 57, wherein the sequences of instructions that cause the electronic device to determine a target audience further comprises sequences of instructions that, when executed, cause the electronic device to:

monitor network usage of users;

determine a preference profile for respective users, wherein the preference profile is based on network usage by the respective users; and

select a subset of users of the network based on the preference profile.

59. ***(Previously Presented)*** The machine readable medium of claim 57, wherein the sequences of instructions that cause the electronic device to determine a target audience further comprises sequences of instructions that, when executed, cause the electronic device to:

determine a preference profile for respective users, wherein the preference profile is based on revealed preferences of the respective users; and

select a subset of users of the network based on the preference profile.

60. ***(Previously Presented)*** The machine readable medium of claim 57, wherein the sequences of instructions that cause the electronic device to monitor redemption of the one or more coupons further comprises sequences of instructions that, when executed, cause the electronic device to:

maintain a coupon database that stores information related to coupons that have been distributed; and

check the coupon database to determine whether a particular coupon is valid.

61. *(Previously Presented)* A method comprising:

determining a target audience of one or more users of devices coupled to a network, wherein the target audience is determined based on one or more preferences of the users stored in the respective users' devices; and

providing a coupon to the target audience determined, wherein providing a coupon to the target audience further comprises:

determining a subset of users of the network based on a preference profile;

delivering one or more coupons to the subset of users; and

monitoring redemption of the one or more coupons to prevent fraud.

62. *(Previously Presented)* A method comprising:

determining a target audience of one or more users of personal computers coupled to a network, wherein the target audience is determined based on one or more preferences of the users stored in the respective users' personal computers; and

providing a coupon to the target audience determined, wherein each coupon may be used a predetermined number of times, wherein providing a coupon to the target audience further comprises:

determining a subset of users of the network based on a preference profile;

delivering one or more coupons to the subset of users; and

monitoring redemption of the one or more coupons such that each coupon may be used a predetermined number of times.



EXHIBIT A



IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MARYLAND
SOUTHERN DIVISION

BLACK DIAMOND CCT HOLDINGS,
LLC, *et al.*,
Plaintiffs,

v.

COUPONS, INC.,
Defendant.

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CIVIL ACTION NO. RDB-02-3701

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MEMORANDUM AND ORDER
RE: PATENT CLAIM CONSTRUCTION

In this case, Plaintiffs Black Diamond CCT Holdings, LLC and E-Centives, Inc. (collectively, “Plaintiffs”) sue Defendant Coupons, Inc. (“Coupons”) for infringement of the claims of United States Patent Nos. 6,336,099 (the “’099 Patent”) and 6,321,208 (the “’208 Patent”) (collectively, the “Patents”).¹ Pursuant to the Scheduling Order, the parties have filed materials relating to what they have specified as material claim construction issues. The Court held a claim construction hearing on Monday, November 10, 2003 for purposes of reviewing the intrinsic evidence of record.

I. GENERAL PRINCIPLES OF CLAIM CONSTRUCTION

The construction of patent claims is a matter for the court. Markman v. Westview Instruments, Inc., 517 U.S. 370, 390 (1996). When constructing a term in a patent claim, “the focus is on the objective test of what one of ordinary skill in the art at the time of the invention would have understood

¹The ‘099 Patent is a continuation of the ‘208 Patent. The specifications of both Patents are nearly identical. The ‘208 Patent is directed toward a method of electronic coupon distribution, while the ‘099 Patent is directed toward a system of electronic coupon distribution.

the term to mean.” Markman v. Westview Instruments, Inc., 52 F.3d 967, 986 (Fed. Cir. 1995) (en banc), aff’d, 517 U.S. 370 (1996).

The Court must first look at the basic evidence of record, namely, the language of the claim, the specification, and the prosecution history. Insituform Tech., Inc. v. Cat Contracting, Inc., 99 F.3d 1098, 1105 (Fed. Cir. 1996), cert. denied, 520 U.S. 1198 (1997). The claim language itself defines the scope of the claim. Therefore, “a construing court does not accord the specification, prosecution history, and other relevant evidence the same weight as the claims themselves, but consults these sources to give the necessary context to the claim language.” Eastman Kodak Co. v. Goodyear Tire & Rubber Co., 114 F.3d 1547, 1552 (Fed. Cir. 1997).

The Court of Appeals for the Federal Circuit has held that claims should be read in view of the specification. See, e.g., id. at 1582. However, the Federal Circuit cautions against limiting the scope of a claim to the preferred embodiment or to specific examples disclosed in the specification. See, e.g., Ekchian v. Home Depot, Inc., 104 F.3d 1299, 1303 (Fed. Cir. 1997); see also Intervet Am., Inc. v. Kee-Vet Lab., Inc., 887 F.2d 1050, 1053 (Fed. Cir. 1989) (“[L]imitations appearing in the specification will not be read into claims, and . . . interpreting what is meant by a word in a claim ‘is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.’”) (citation omitted).

II. DISCUSSION

A. The Patents and Claims at Issue

In broad terms, the Patents describe an Internet-based, print-at-home, secure couponing service, which generates customized and targeted discount coupons and other marketing incentives in

response to information provided by individual users or groups of users, and which enables the detection and prevention of fraud. Plaintiffs assert infringement of Claims 1-7 of the '208 Patent and Claims 1-8, 10-22, 24-35, and 37-40 of the '099 Patent. The parties seek the Court's construction of the terms that are highlighted below:

1. The '208 Patent:

Independent Claim 1 of the '208 Patent contains the following disputed terms:

An online method for a user to view and print at a remote terminal user-specific coupons based on a user profile, the method comprising the steps of:

- (a) storing in a storage device at a central location electronic coupon information pertaining to a group of coupons available;
- (b) receiving a request from a user for access to stored coupon information;
- (c) determining if the user is a registered user, and if the user is not registered:
 - (i) transmitting a prompt to the remote terminal to electronically complete a user profile and transmit the user profile to the central location;
 - (ii) receiving and storing a user profile at the central location; and
 - (iii) downloading to the remote terminal a coupon data management software module for managing the printing of coupons, including unique user identification information;
- if the user is registered, accessing the stored user profile;
- (d) viewing, by a remote terminal, selected ones of the stored coupons, the selected coupons being based on user-specific information, which comprises user profile information and/or user usage history information;
- (e) receiving at the central location a request to transmit to the remote terminal at least one coupon data file, the coupon data file corresponding to a user selected coupon, the coupon data file comprising various fields, including a redemption amount field and other fields, the redemption amount field being indicative of a discount provided by the

coupon, the redemption amount field and at least one other field being variable in accordance with user-specific information associated with the requesting user; and

- (f) transmitting to the remote terminal the at least one coupon data file to enable the user to print a coupon using the coupon data management software module.

'208 Patent, col. 14, ll. 8-47. The disputed terms in the dependent claims of the '208 Patent also appear in independent Claim 1 and therefore will be interpreted to have the same meanings as they have in the independent claim.

2. The '099 Patent:

The '099 Patent contains two independent claims, Claims 1 and 21, which are substantially identical except for the final paragraph. Claim 1 states:

A central, computer-based system for providing remote users with access via remote terminals to user-specific incentives based at least in part on user-specific information over an online network, the central system comprising:

a central data repository having memory in which is stored incentive offer data and remote user data;

at least one server operatively associated with the central data repository for accessing and storing incentive offer and remote user data;

at least one communication device in operative association with the server, whereby the central system establishes an electrical communication with a remote terminal operated by a remote user, whereby the central system obtains remote user data, including user-specific information; and

a graphical user interface in association with the server and the remote terminal for presenting to the remote user at the remote terminal one or more retailers and one or more incentive offers associated with the user selected retailer, the remote terminal communicating the user selection to the central system, the central system generating a user-specific incentive associated with each selected offer for redemption by the remote user.

'099 Patent, col. 14, ll. 14-40; see also '208 Patent, col. 15, l. 54 - col. 16, l. 2. The final paragraph of Claim 21 differs in its language and provides:

a graphical user interface in association with the server and the remote terminal for presenting to the remote user at the remote terminal one or more categories of goods or services and one or more incentive offers associated with the goods or services for user selection, the presentation being based at least in part on the user-specific information, whereby the user selects a good or service and one or more incentive offers associated with the user selected good or service, the remote terminal communicating the user selection to the central system generating a user-specific incentive concerning each user selected offer for redemption by the remote user.

'099 Patent, col. 16, ll. 3-14. Certain of the disputed terms in the dependent claims of the '099 Patent also appear in independent Claims 1 and 21 and will be interpreted to have the same meanings as they have in the independent claim. The terms "other fields" and "various fields" in dependent Claims 2 and 28 are disputed and do not appear in the independent claims. Claim 2 states:

The system of Claim 1, wherein the user-specific incentive generated by the central system is transmitted to the remote terminal and includes at least one incentive data file, the incentive data file corresponding to the user selected offer, the incentive data file comprising **various fields**, including a redemption amount field, and **other fields**, the redemption amount field being indicative of a discount provided by the selected offer, at least one field being variable in accordance with user-specific information associated with the requesting user.

Id., col. 14, ll. 41-50. Claim 28 is substantially the same as Claim 2, except it depends on Claim 21 instead of Claim 1. See id., col. 16, ll. 30-38. Accordingly, the terms will be construed as having the same meaning in both dependent claims.

Finally, Claims 5 and 31 are disputed in their entirety. Claim 5 states: "**The system of Claim 1, wherein the user-specific information includes a zip code, city, state, user address, user name, or user telephone number.**" Id., col. 14, ll. 65-67. Claim 31 is substantially the same as

Claim 5, except it depends on Claim 21 instead of Claim 1. See id., col. 16, ll. 51-53. These terms will be construed as having the same meaning in both dependent claims.

B. Construction of the Claim Language

1. User

“Although words in a claim are generally given their ordinary and customary meaning, a patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is clearly stated in the patent specification or file history.” Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996) (citing Hoechst Celanese Corp. v. BP Chems. Ltd., 78 F.3d 1575, 1578 (Fed. Cir. 1996)). Plaintiffs define the term “user” by reference to the ‘208 Patent specification as “an individual or household of users.” See ‘208 Patent, col. 6, ll. 50-51 (“[a]s used herein, the term ‘user’ denotes an individual user or a household of users linked through one account.”). Ordinarily, the specification is dispositive as to the meaning of a disputed term when it expressly defines terms used in the claims. Vitronics Corp., 90 F.3d at 1582. However, in this case, the specification contains alternate definitions for the term “user,” one of which is not supported or enabled by the specification. For instance, the specification contains no provision for the establishment of an “account” for purposes of utilizing the electronic coupon distribution service. The specification also does not define what combination of individuals may constitute a “household” for purposes of utilizing the system and does not identify how members of a “household” may be linked through a single account.

Coupons asserts that the specification and prosecution history teach that the system works only if the “user” is an individual. It cites portions of the specification that discuss the printing of a user-

specific bar code on each coupon to prevent duplication and multiple redemption. See '208 Patent, col. 5, ll. 49-62. "The user bar code is encoded with user-specific information such as the name and/or other unique identification criteria such as a social security number or online service address. This information renders each printed coupon 18 unique, since an otherwise similar coupon presented by a different consumer will comprise a different user bar code 90." Id., col. 7, ll. 21-34.

Coupons also cites portions of the June 12, 1997 Amendment for the proposition that the '208 Patent distinguishes itself from the DeLapa Patent, which encodes each coupon with a machine-readable code that identifies the household of the consumer. 6/12/97 Amdt. at 15-16. However, DeLapa is distinguishable from the present invention not because of the information encoded on each coupon, but rather because of the method by which unique coupons are assembled. Whereas the coupons referenced in DeLapa are printed at a central site and then sent to the user in hard copy, the coupons generated by the instant invention are printed from the user's own computer using data stored on that computer and data obtained from the coupon repository. Therefore, Coupons' reliance on the June 12, 1997 Amendment seems misplaced.

In the April 30, 1998 Amendment, however, the patentee notes that each coupon is personalized with user-specific data pertinent only to an individual and not multiple individuals, such as the user's name or social security number. 4/30/98 Amdt. at 10-11. The purpose of including such information is to facilitate detection of duplicative redemptions and to allow manufacturers to track and analyze who has requested coupons and who has actually used them. Id.

The specification notes that the coupon distribution center utilizes the user-specific redemption data along with user-specific demographic data supplied by the online service provider in order to

compile subsequent coupon data download packages for use by consumers. '208 Patent, col. 7, ll. 51-55. By way of example, the specification states that "it may be determined by the analysis means that users with dogs in their household (which is known by the demographic responses) will get a certain package comprising dog food coupons." Id., col. 12, ll. 41-44. A user's selection, printing, and redemption of certain coupons will trigger a further customized response from the system. See id. Because the demographic information provided by each user is broad enough to encompass the preferences of members of the user's household (thus facilitating targeted marketing of households), it would be inconsistent to define the term "user" as multiple members of the same household. Plaintiffs' definition of the term to include members of a household linked through one account is rejected as overbroad and unsupported by the specification or patent history. See Genentech, Inc. v. Wellcome Foundation Ltd., 29 F.3d 1555, 1564 (Fed. Cir. 1994). Accordingly, the term "user" shall be construed to mean an individual who utilizes the electronic coupon distribution service to request and obtain coupons or incentives.

2. Remote User

The term "remote user" appears in independent Claims 1 and 21 and several dependent claims of the '099 Patent and is not defined in the specification. Therefore, the Court will construe the term in accordance with its plain and ordinary meaning. Quantum Corp. v. Rodime, PLC, 65 F.3d 1577, 1580 (Fed. Cir. 1995) ("[T]he words of a claim will be given their ordinary meaning to one of skill in the art unless the inventor appeared to use them differently."). Claim 1 of the '099 Patent supports such a construction. See '099 Patent, col. 14, ll. 15-16 and 25-26 ("a central, computer based system for providing remote users with access via remote terminals"). The specification's definition of a remote

user computer or remote terminal provides further support. See '099 Patent, col. 4, ll. 50-54 ("The remote user computer in the present invention comprises interface means for providing user interaction with the centrally located repository, a memory, and a coupon data management program.")). Accordingly, the term "remote user" shall be construed as a user who accesses the system using a remote terminal or a remote user computer.

3. Remote User Data

“Remote user data” appears in Claims 1 and 21 of the ‘099 Patent and dependent Claim 19 and is not defined in the specification. Plaintiffs’ definition of the term as “data pertaining to a remote user” is overbroad. See SRI Int’l v. Matsushita Elec. Corp., 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc) (claim language defines claim scope). The claims expressly limit the definition to data that is obtained by and stored at the central repository and which includes user-specific information (as defined below) and “prior selection and redemption data associated with the remote user.”

4. Registered User

The term “registered user,” as used in Claim 1(c) of the ‘208 Patent, must be construed in accordance with its plain and ordinary meaning to a person skilled in the art. Plaintiffs’ proposed construction is supported by reference to the American Heritage College Dictionary (3d ed. 1993), which defines “register” as “[t]o enroll officially or formally . . .” or “to place one’s name in a register.” In addition, the specification describes the process of initial registration for the electronic coupon distribution service as follows:

An online display screen 60 is shown in FIG. 4a, which is provided to a user on a display 24 of his remote computer 6 whenever he is in online communication with the service provider 2. The online display screen 60 comprises a join service function button 62, a download coupons function button 64, a help function button 66, and an online communications button 68. When the user desires to initially register for the electronic coupon distribution service, he selects the join service function button 62 which initiates a dialog with the online service provider 2 in order to request certain demographic data from the user which will be used to target specific coupon data packages for subsequent downloading. The user has the option of providing the requested information if he so desires. In addition, an offline coupon management program is transmitted electronically to the user’s computer 6 for subsequent coupon data requesting, downloading and processing.

'208 Patent, col. 7, l. 56-col. 8, l. 5. Therefore, the Court construes the term "registered user" to mean a user who has become eligible to utilize the electronic coupon distribution service by joining the service and thus registering with the system.

5. User Profile

The term "user profile" appears in Claim 1(c)(i) of the '208 Patent. If the user is not a registered user, the system will "transmit[] a prompt to the remote terminal to electronically complete a user profile and transmit the user profile to the central location." '208 Patent, col. 14, ll. 19-20. Claim 1(c)(ii) states that the user profile will be received and stored at the central location. *Id.*, col. 14, ll. 22-23. The term subsequently appears in dependent Claim 6: "The method of claim 1 wherein the user profile comprises demographic data associated with the user." *Id.*, col. 14, ll. 56-57.

The term does not appear in the specification. The specification contains numerous references to a demographic data file, which contains demographic data obtained from the user at the time of initial registration, data representative of responses to demographic inquiries presented to the user at the time the user requests a download of coupon data, and a record indicative of each coupon selected by the user and printed by the user. *See* '208 Patent, col. 5, ll. 6-12; col. 6, ll. 58-62; col. 7, ll. 62-col. 8, l. 1; col. 8, ll. 34-38; col. 9, ll. 46-53; col. 10, ll. 51-57. However, it is unclear from the specification how much of the information contained in the demographic data file comprises the user profile. Accordingly, in the absence of guidance from the specification, the Court construes the term "user profile" in a manner consistent with the claims to mean a summary of demographic data provided by the user in response to requests during the initial registration process.

6. User Profile Information

Claim 1(d) of the '208 Patent identifies "user profile information" as a subset of "user-specific information." '208 Patent, col. 14, ll. 30-34 ("the selected coupons being based on user-specific information, which comprises user profile information and/or user usage history information.'). The specification is silent as to the definition of the term. The Court construes the term to mean information in the user profile.

7. Unique User Identification Information

The term "unique user identification information" appears in Claim 1(c)(iii) of the '208 Patent in the following context: "downloading to the remote terminal a coupon data management software module for managing the printing of coupons, including unique user identification information . . ." '208 Patent, col. 14, ll. 24-27. The specification notes that coupons are printed by the coupon data generation routine, which relies on fixed coupon data transmitted to the user's computer during the registration process and variable coupon data that is transmitted to the user's computer whenever he requests coupon data from the central repository. *Id.*, col. 5, ll. 6-13. In the preferred embodiment, the fixed data includes a user identification bar code number, which is a unique number assigned to the user, for example his social security number or online identification number. *Id.*, col. 11, ll. 2-4. The number is encoded by the printable coupon data generation routine and is printed as a bar code on each coupon printed for the particular user. *Id.*, col. 11, ll. 4-7. One purpose of the user identification bar code is to render printed coupons unique as between users, and thus to prevent duplication and multiple redemption of the same coupon. Reading the disputed term in the context of the specification,

the Court construes the term “unique user identification information” to mean information that is stored on the user’s remote terminal that uniquely identifies the user.

8. User Usage History Information

The term “user usage history” appears in Claim 1(d) of the ‘208 Patent and, like the term “user profile information,” is described as a subset of “user-specific information.” See ‘208 Patent, col. 14, ll. 30-34. The specification makes clear that the coupon distributor collects information regarding the coupon data selected by the user, the coupon data printed by the user, and demographic information relating to the user. *Id.*, col. 12, ll. 28-33. The coupon distributor also collects and stores information from the coupon redemption center about the coupons actually redeemed. *Id.*, col. 12, ll. 33-35. That information is analyzed, and, based on marketing and targeting criteria and objectives, different coupon packages are generated and transmitted to the online service provider. *Id.*, col. 12, ll. 53-55. Accordingly, the Court construes “user usage history” to mean data relating to a user’s selection, printing and redemption of coupons over time.

9. User-specific Information

The term “user-specific information” appears primarily in Claims 1(d) and 1(e) of the ‘208 Patent and in Claims 1 and 21 of the ‘099 Patent. According to Claim 1(d) of the ‘208 Patent, user-specific information may include user profile information and user usage history information. Claim 1 of the ‘099 Patent describes user-specific information as a subset of remote user data that is transmitted to the central system. The specification indicates that user-specific information, which may include the user’s name, social security number, or online service address, is encoded in each coupon “in the form

of a unique user bar code 90” and “renders each printed coupon unique.” See ‘099 Patent, col. 7, ll 26-32. The Court adopts Plaintiffs’ proposed definition of the term, “information specific to a user.”

10. Central Data Repository

Defendant accepts Plaintiffs' proposed construction of the term "central data repository" in Claims 1 and 21 of the '099 Patent as any centrally located computer system that stores electronic coupon information (including incentive offer data and product redemption coupon data) and remote user data, said computer system comprising one or more computers or Internet sites. The proposed construction is supported by the claims and specifications. See '099 Patent, col. 14, ll. 19-20; col. 4, ll. 41-54; col. 6, ll. 47-49, 52-65; Fig. 1.

11. Central Location

Defendant also accepts Plaintiffs' proposed construction of the term "central location" in Claim 1(a) of the '208 Patent as "a location where electronic coupon data and/or user information is stored." That construction is supported by the claims and specifications. See '208 Patent, col. 14, ll. 11-13, 19-23; col. 4, ll. 40-48.

12. At Least One Server Operatively Associated with the Central Data Repository

This phrase appears in Claim 1 of the '099 Patent in the following context: "at least one server operatively associated with the central data repository for accessing and storing incentive offer and remote user data." '099 Patent, col. 14, ll. 21-23. The specification does not describe the use of a server in this context. Rather, the specification describes only an "online communication server," which operates as a "bulletin board file where users can post messages to a coupon distributor or issuer regarding any issue of interest." See id., col. 8, ll. 39-48; Fig. 6.

Plainly, the definition of server should not be restricted to this definition, because an electronic bulletin board that facilitates communication with a coupon distributor or issuer does not perform the claimed functions of accessing and storing incentive offer and remote user data. The Court therefore must construe the term in accordance with its plain and ordinary meaning to one skilled in the art. Newton's Telecom Dictionary 920 (8th ed. 1994) defines "server" as "a shared computer on the local area network that may be . . . used as a repository and distributor . . . of data." "Operatively associated with the central data repository" shall be construed to mean that the server operates in conjunction with the central data repository.

13. Coupon Data Management Software Module

The term "coupon data management software module" appears in Claims 1(c)(iii) and 1(f) of the '208 Patent as a computer program that is downloaded from the central location to the remote terminal and performs the function of "managing the printing of coupons, including unique user identification information." See '208 Patent, col. 14, ll. 23-26, 43-45. The specification describes other functions performed by the coupon data management software module:

The coupon data management program is implemented by the [remote user] computer for requesting coupon data from the centrally located repository, for storing in the memory coupon data transmitted from the centrally located repository, and for generating printable coupon data from the stored coupon data. The remote user computer also comprises a coupon output buffer operatively associated with the data management program for storing the printable coupon data generated by said coupon data management program.

'208 Patent, col. 4, ll. 48-60.

Additionally, the coupon data management program of the present invention operates in conjunction with the remote computer to allow the

user to select and store certain desired coupon data from the coupon data transmitted by the centrally located repository and print coupons as selected. The coupon data management program also allows the user to generate a shopping list which is correlated to the coupons printed for subsequent redemption.

Id., col. 5, ll. 14-21. Viewing the term in light of the specification, the Court construes “coupon data management software module” to mean a software program downloaded to the remote terminal that performs coupon data management functions, including the printing of coupons.

14. Communication Device

The term “communication device” in Claim 1 of the ‘099 Patent appears in the following context: “at least one communication device in operative association with the server, whereby the central system establishes an electrical communication with a remote terminal operated by a remote user, whereby the central system obtains remote user data, including user-specific information” The Court construes the term in accordance with its plain meaning to mean a component that facilitates the transmission of information or data between the central system and the remote terminal. See McGraw-Hill Dictionary of Scientific and Technical Terms 416, 553 (5th ed. 1994) (defining “communication” as “transmission of intelligence between two or more points over wires or by radio” and “device” as a computer or computer component).

15. Graphical User Interface

The term “graphical user interface” appears in Claims 1 and 21 of the ‘099 Patent in the following context:

a graphical user interface in association with the server and the remote terminal for presenting to the remote user at the remote terminal one or more retailers and one or more incentive offers associated with the

retailers for user selection, the presentation being based at least in part on the user-specific information, whereby the user selects a retailer and one or more incentive offers associated with the user selected retailer, the remote terminal communicating the user selection to the central system, the central system generating a user-specific incentive associated with each selected offer for redemption by the remote user.

'099 Patent, col. 14, ll. 30-41. Defendant argues that the functional language in the claims is unsupported and not enabled by the specification and, therefore, the claims are invalid. The Court here is concerned only with the construction of the disputed claim terms and does not resolve the question of whether the claims are invalid. In the absence of language in the specification interpreting the term "graphical user interface," the Court gives the term its ordinary meaning. The term shall be construed in accordance with Plaintiffs' proposed definition as a "visual computer interface that enables a user to issue commands using a pointing device." See Newton's Telecom Dictionary 488-89 (8th ed. 1994) (defining graphical user interface as a device which "lets users get into and out of programs and manipulate the commands in those programs by using a pointing device (often a mouse)).

16. User Specific Coupons

Defendant accepts Plaintiffs' proposed construction of the term "user specific coupons" in Claim 1 of the '208 Patent as "coupons specific to a user." That construction is supported by the specification. See '208 Patent, col. 5, ll. 46-62; col. 7, l. 62-col. 8, l. 1.

17. Electronic Coupon Information

Defendant accepts Plaintiffs' proposed construction of the term "electronic coupon information" in Claim 1(a) of the '208 Patent as "electronic information relating to coupons." That construction is supported by the claim and specification. See '208 Patent, col. 14, ll. 11-13 ("storing in a storage

device at a central location electronic coupon information pertaining to a group of coupons available”); col. 6, ll. 52-57; Figs. 6 and 10.

18. User Specific Incentives

Defendant accepts Plaintiffs’ proposed construction of the term “user-specific incentives” in Claims 1 and 21 of the ‘099 Patent as “incentives specific to a user.” That construction is supported by the specification and the construction of the term “user specific coupons” in the ‘208 Patent. See, e.g., ‘099 Patent, col. 6, ll. 58-65; col. 7, ll. 51-55.

19. Various Fields; Other Fields; At Least One Other Field Being Variable in Accordance with User-Specific Information

The terms “various fields” and “other fields” appear in the following context in Claim 1(e) of the ‘208 Patent: “the coupon data file comprising various fields, including a redemption amount field and other fields, the redemption amount field being indicative of a discount provided by the coupon, the redemption amount field and at least one other field being variable in accordance with user-specific information associated with the requesting user” The terms also appear in Claims 2 and 28 of the ‘099 Patent with reference to an incentive data file.

The variable coupon data fields are depicted in Fig. 3 and include the expiration date, redemption amount, company and product data, UPC code, redemption address, and offer description. See also ‘208 Patent, col. 11, ll. 24-32. In addition, Fig. 3 depicts various fixed coupon data fields, including the border graphics, redemption instructions, and user identification bar code. The user’s computer assembles coupons for printing by using the fixed coupon data and user-specific information, which are stored on the user’s computer, and variable coupon data, which is transmitted to the user’s

computer when he requests coupon data from the central repository. '208 Patent, col. 5, ll. 6-13; see also col. 10, ll. 58-64. The user-specific information encoded on each coupon in the form of a user identification bar code number is variable as between different users.

Referring to FIG. 3, the data format of the fixed coupon parameters and user-specific data are set forth and include predefined border graphics which are the same for every coupon printed, redemption instructions, and a user identification bar code number. The user identification bar code number is a unique number assigned to that user, e.g. his social security number or online identification number. This number will be encoded by the printable coupon data generation routine 32*d* and printed as a bar code 90 on each coupon 18 printed for the particular user. This information will thus be obtained by the coupon redemption center and provided to the coupon distributor 16 for demographic analysis and the like.

'208 Patent, col. 10, l. 65-col. 11, l. 10. The nature of the offer presented to the user may vary in accordance with demographic information provided by the user:

The amount of the redemption discount included with a coupon downloaded to a user may be varied depending on certain demographic information that the system has about the user. For instance, the system may provide a certain value for known users of a brand (which information it will obtain by demographic inquiry or through previous redemptions in the system), and it may provider [sic] a higher discount in order to provide an incentive to users of a competitive brand. The ability to vary the value of a discount offer in accordance with such demographic and usage data is a unique advantage offered by the system of the present invention and heretofore unavailable in the prior art.

Id., col. 13, ll. 24-35. As Defendant correctly notes, the prosecution history distinguishes the present invention from the prior art: "Notably, the coupon data file comprises a redemption amount field with redemption amount data that is variable prior to transmission in accordance with a profile associated with the user such that users with different profiles may be provided with coupon data files having

different redemption amounts for the same product.” 4/30/98 Amdt. at 17 (adding limitation to pending claim 47).

In light of the prosecution history and the specification, the Court will construe “various fields” to mean fields of data in the coupon data file. “Other fields” shall mean those fields in the coupon data file other than the redemption amount field. “At least one other field being variable in accordance with user-specific information associated with the requesting user” means that at least one field in the coupon data file other than the redemption amount field will change based on a user’s demographic information and/or prior coupon usage information known to the system.

20. Viewing . . . Selected Ones of the Stored Coupons

Claim 1(d) of the ‘208 Patent recites the disputed phrase “viewing, by a remote terminal, selected ones of the stored coupons, the selected coupons being based on user-specific information, which comprises user profile information and/or user usage history information.” In the preferred embodiment, electronic coupon data is stored in a centrally located repository, and requested coupon data packages are downloaded to a user’s remote computer. ‘208 Patent, col. 6, ll. 30-34; col. 8, ll. 29-33. A user subsequently may view the coupons and advertisements previously downloaded by selecting the view function button 52. *Id.*, col. 9, ll. 54-55. That selection will “call the view coupons routine 32*b*, which will access the downloaded coupon data file 30*a* and present it to the user via the display 24.” *Id.*, col. 9, ll. 56-58. Accordingly, the Court will construe the phrase to mean viewing, by a remote terminal, those coupons which are downloaded to the remote terminal.

21. Claims 5 and 31 of the ‘099 Patent

Dependent Claim 5 of the '099 Patent claims "[t]he system of claim 1, wherein the user-specific information includes a zip code, city, state, user address, user name, or user telephone number." Dependent Claim 31 derives from Claim 21 and claims the same additional elements. The claim terms are self-explanatory and must be accorded their ordinary meaning. The Court does not reach Defendant's argument that the claim is overbroad and not enabled or supported by the specification or prosecution history.

III. CONCLUSION

For the foregoing reasons, the Court concludes the following with regard to the construction of the claim terms at issue:

1. The term “user,” as used throughout the Patents, is construed to mean an individual who utilizes the electronic coupon distribution service or system to request and obtain coupons or incentives.
2. The term “remote user” in Claims 1 and 21 of the ‘099 Patent is construed to mean a user who accesses the system using a remote terminal or a remote user computer.
3. The term “remote user data” in Claims 1 and 21 of the ‘099 Patent is construed to mean prior selection and redemption data associated with the remote user.
4. The term “registered user” in Claim 1(c) of the ‘208 Patent is construed to mean a user who has become eligible to utilize the electronic coupon distribution service by joining the service and thus registering with the system.
5. The term “user profile” in Claim 1(c)(i) of the ‘208 Patent is construed to mean a summary of demographic data provided by the user in response to requests during the initial registration process.
6. The term “user profile information” in Claim 1(d) of the ‘208 Patent is construed to mean information in the user profile.
7. The term “unique user identification information” in Claim 1(c)(iii) of the ‘208 Patent is construed to mean information that is stored on a user’s remote terminal that uniquely identifies the user.
8. The term “user usage history information” in Claim 1(d) of the ‘208 Patent is construed to mean data relating to a user’s selection, printing and redemption of coupons over time.
9. The term “user-specific information” in Claims 1(d) and 1(e) of the ‘208 Patent and in Claims 1 and 21 of the ‘099 Patent is construed to mean information specific to a user.

10. The term "central data repository" in Claims 1 and 21 of the '099 Patent is construed to mean any centrally located computer system that stores electronic coupon information (including incentive offer data and product redemption coupon data) and remote user data, said computer system comprising one or more computers or Internet sites.
11. The term "central location" in Claim 1(a) of the '208 Patent is construed to mean a location where electronic coupon data and/or user information is stored.
12. The phrase "at least one server operatively associated with the central data repository" in Claim 1 of the '099 Patent is construed to mean at least one server that operates in conjunction with the central data repository.
13. The term "coupon data management software module" in Claims 1(c)(iii) and 1(f) of the '208 Patent is construed to mean a software program downloaded to the remote terminal that performs coupon data management functions, including the printing of coupons.
14. The term "communication device" in Claim 1 of the '099 Patent is construed to mean a component that facilitates the transmission of information or data between the central system and the remote terminal.
15. The term "graphical user interface" in Claims 1 and 21 of the '099 Patent is construed to mean a visual computer interface that enables a user to issue commands using a pointing device.
16. The term "user specific coupons" in Claim 1 of the '208 Patent is construed to mean coupons specific to a user.
17. The term "electronic coupon information" in Claim 1(a) of the '208 Patent is construed to mean electronic information relating to coupons.
18. The term "user specific incentives" in Claims 1 and 21 of the '099 Patent is construed to mean incentives specific to a user.
19. The term "various fields" as used in Claim 1(e) of the '208 Patent and Claims 2 and 28 of the '099 Patent is construed to mean fields of data in the coupon data file. The term "other fields" as used in those claims shall mean those fields in the coupon data file other than the redemption amount field.

20. The phrase “at least one other field being variable in accordance with user-specific information associated with the requesting user” in Claim 1(e) of the ‘208 Patent and Claims 2 and 28 of the ‘099 Patent is construed to mean that at least one field in the coupon data file other than the redemption amount field will change based on the user’s demographic information and/or prior coupon usage information known to the system.
21. The phrase “viewing, by a remote terminal, selected ones of the stored coupons” in Claim 1(d) of the ‘208 Patent is construed to mean viewing, by a remote terminal, those coupons which are downloaded to the remote terminal.
22. The phrase “zip code, city, state, user address, user name, or user telephone” in Claims 5 and 31 of the ‘099 Patent are construed in accordance with their ordinary meaning.

IT IS SO ORDERED this 16th day of December 2003.

/s/

Richard D. Bennett
United States District Judge